

App. No. 09/275,097
Amdt. Dated 11/03/2005
Reply to Office action of August 3, 2005

Remarks

The allowance of claims 12-22 and 34 – 46 is noted with appreciation.

Former claims 1 and 2 have been combined, as have former claims 23, 24, 25, and 26. No new issue arises since the claims now on file were previously present in the application in dependent form.

The applicants find the Examiner's position is interesting, and respectfully request him to reconsider it in the light of the following remarks, and in the light of the claim amendments.

The applicants have generally taken the requirement that each claim limitation be suggested by the prior art (MPEP 2143.03) to mean that if, for example, the claim of the application under examination recites steps *a, b, c, d*, and the primary reference teaches steps *a, b, c*, the secondary reference must teach step *d*. Of course, there must also be a valid motivation to combine the references.

One step clearly missing in Hsing is the recited step of sending connection release messages in a priority sequence. It is quite clear that Arslan does not teach the recited step in claim 1 of sending connection release messages "toward said source or destination entity in a sequence which corresponds to the priority hierarchy from the switched connection associated with the highest priority level to the connection associated with the lowest priority level". Arslan uses the priority information in the restoration processors to restore connections at the various nodes associated with the respective restoration processors. In other words, in Arslan, the priority information is used purely at the level of the local node associated with the restoration processor. There is no teaching of using this information to sequence the sending of connection release messages back to the source or destination in accordance with their priority, as recited in claim 1. This step recited in claim 1 is therefore completely lacking in the prior art.

The Examiner however has not asserted that Arslan teaches the step of sending connection release messages back to the source or destination in a priority sequence, but merely, if the applicants correctly understand his position, that Arslan teaches priority restoration, and therefore if one skilled in the art were to take this abstract concept, rather than the specific concrete process step associated with it, from Arslan, and apply it to

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Hsing, one would end up with a system wherein priority release messages were sent back to the source or destination according to priority. This methodology is, in the applicant's respectful submission, improper because the teaching of the prior art must be considered in its entirety (MPEP 2141.02). The actual concrete process step associated with the concept must be combined with the primary reference, not merely the underlying abstract idea. The concrete process step that Arslan teaches is to use priority information to determine the order in which connections are established at a particular node by the restoration processor. There is, however, as the applicants understand Arslan, no teaching that messages are sent to other processors using this priority information. If the Examiner refers to the passage commencing at col. 8, line 48 of Arslan, he will see that when a node receives a message indicating a disrupted circuit, it sends "takedown information with the appropriate CIRCUIT-STATE element, to distributed communications manager 205, for transmission to distributed communications manager 205 of adjacent restoration processors 115 of nodes this circuit traverses". The CIRCUIT-STATE element contains restoration priority information that is used by the restoration processor of the receiving node, but there is no indication that this initial takedown information including the appropriate CIRCUIT_STATE element is sent in any particular order. The step of sending out messages of any kind to other nodes in accordance with this priority information appears to be completely lacking in Arslan. This is an important distinction that the Examiner appears to have overlooked.

It is however also noted that the applicants have combined claims 1 and 2. The Examiner requires three references to allege obviousness of former claim 2. One must be careful not to pick and choose among references. In order to establish a *prima facie* case of obviousness, the Examiner must consider what a person skilled in the art *would* do, not what he *could* do. "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS" (MPEP 21430.01). Also, the claimed invention must be considered "AS A WHOLE" (MPEP 2141.02).

Firstly, it is respectfully submitted that in the context of the invention, which is concerned with the controlled release of connection Ticdemann is non-analogous art.

In considering this question, the Federal circuit stated in *In re Wood*, 202 USPQ 171, that

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"we presume knowledge by the inventor of all the prior art in the field of his endeavour. However, with regard to prior art outside the field of his endeavor, we presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved." (emphasis added)

And in *In re Clay*, 23 USPQ 2d 1058, the Federal circuit stated:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commanded itself to the inventor's attention in considering his problem...If a reference has the same purpose as the claimed invention, the reference relates to the same problem... [I]f it is directed to a different purpose, the inventor would accordingly have less motivation or occasion to consider it."

Tiedemann is concerned with the scheduling of scheduling reverse links in a CDMA transmission system (see col. 4, line 41), and it is not therefore clear why this reference would command itself to a person concerned with improving the efficiency of networks in the event of link failure. Tiedemann is directed to an entirely different problem, and as such must be considered non-analogous art.

Moreover, the Examiner has just taken one paragraph in Tiedemann in isolation, wherein he discloses making a priority list of scheduled users, and wherein this list is then used to assign reverse link capacity to the scheduled users in accordance with the priority list, and applied it out of context to an entirely different situation. The alleged motivation must be found in the prior art. The Examiner states that the motivation is "in order to simplify and expedite the determination and selection of the highest priority connections", but the applicants are unable to find any teaching in the prior art, and in particular in Tiedemann that the use of an ordered list achieves this result. As noted above, the obviousness does not depend on what one skilled in the art could do, but it is rather a question of what he would do in the light of the prior art teachings.

In summary, in the applicants submission the analogous prior art, when fairly construed, does not teach a method for controlling the ordered release of connections in a priority

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sequence as more particularly defined in claim 1. Similar arguments apply to claim 23,
which is the apparatus equivalent of claim 1.

It is believed that this application, as amended, is in condition for allowance.

Accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,



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Applicant(s): John BURNS, et al.			
Serial No. 09/275,097	Filing Date 24 March 1999	Examiner HARPER, Kevin C.	Group Art Unit 2666
Invention: METHOD AND APPARATUS FOR PRIORITIZED RELEASE OF CONNECTIONS IN A COMMUNICATIONS NETWORK			
<p>I hereby certify that this <u>RESPONSE TO THE OFFICE ACTION MAILED 08/03/2005</u> <small>(Identify type of correspondence)</small> is being facsimile transmitted to the United States Patent and Trademarks Office (Fax. No. <u>1-571-273-8300</u>) on <u>2 November 2005</u> <small>(Date)</small></p> <p style="text-align: center;">PAT MARTIN <small>(Typed or Printed Name of Person Signing Certificate)</small></p> <p style="text-align: center;"> <small>(Signature)</small></p>			
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